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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,144	09/19/2003	Michael T. Carley	16497.1.1.5	7207
22913 7590 05/12/2008 WORKMAN NYDEGGER 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111				
EXAMINER				
BACHMAN, LINDSEY MICHELLE				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
05/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/667,144

Applicant(s)

CARLEY ET AL.

Examiner

LINDSEY BACHMAN

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 19 and 36-49 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 17, 19 and 36-49 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 19 January 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date 10-30-07, 2-19-08
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 19 February 2008 has been entered.

Claim Objections

Claims 45, 46 and 47 are objected to as being dependent upon a cancelled claim(s). As such, these claims have not been further treated on the merits thereof.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

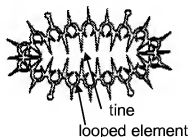
1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17-20, 36-41, 43-46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spence, et al. (US Patent 6,488,692) in view of Peterson et al (US Patent 6,599,303).

Claim 17: Spence'692 discloses a clip having a ring-shaped body (MR) defining a plane and disposed about a central axis (intersection of lines B-B and MLA in Figure 7), the body (MR) is capable of being moved from a substantially planar configuration to a transverse configuration because it is malleable (column 8, lines 16-23). Further, the body (MR) contains a plurality of loop elements (see alternate embodiment in Figure 9b) and a plurality of tines (see labeled copy of Figure 9b below) extending from the looped elements towards the central axis. Further, Spence'692 teaches spring elements (MD) that can be used to shape the clip (column 8, lines 25-30).



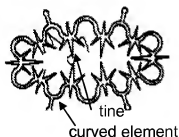
Spence'692 does not teach a biased spring element that limits the penetration depth of the adjacent tines.

Peterson'303 teaches a device for engaging tissue that contains a device with tines (16) with biased spring elements (18) between adjacent tines that resiliently allow the tips of the tines to be moved away from one another and also limit the penetration

depth of the tines (see Figure 2, 3, and 10-14, for example, but other configurations disclosed by Peterson'303 may also show this). This spring element extends in the same direction as the tines. It would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the device taught by Spence'692 with the biased spring elements extending in the same direction as the tines, as taught by Peterson'303, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding Claim 19, Spence'692 discloses the looped elements (see Figure above) is a series of outer curved regions connected to one another and the tines (see Figure above) extend from the connection regions of the adjacent curved regions.

Regarding Claims 36, Spence'692 discloses a clip having a ring-shaped body (MR) defining a plane and disposed about a central axis (intersection of lines B-B and MLA in Figure 7), the body (MR) is capable of being moved from a planar configuration to a transverse configuration because it is malleable (column 8, lines 16-23). Further, the body (MR) contains a plurality of curved elements (see alternate embodiment in Figure 9c) and a plurality of arcuate tines (see labeled copy of Figure 9c below and arcuate features in element TB in Figure 8a) extending from the looped elements towards the central axis. Further, as shown in Figure 8a, the tines are arcuate at the point that the tine extends from the ring. Further, Spence'692 teaches spring elements (MD) that can be used to resiliently move the tops of the tines away from each other (column 8, lines 25-30).



Spence'692 does not teach a biased spring element that limits the penetration depth of the adjacent tines.

Peterson'303 teaches a device for engaging tissue that contains a device with tines (16) with biased spring elements (18) between adjacent tines that resiliently allow the tips of the tines to be moved away from one another and also limit the penetration depth of the tines (see Figure 2, 3, and 10-14, for example, but other configurations disclosed by Peterson'303 may also show this). This spring element extends in the same direction as the tines. It would have been obvious to one of ordinary skill in the art at the time the invention was made to rearrange the device taught by Spence'692 with the biased spring elements extending in the same direction as the tines, as taught by Peterson'303, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claim 37, 38, 39: The plurality of tines contains primary tines and secondary tines having different lengths (see Figure 9b). The secondary tines are disposed on either side of the primary tines (see Figure 9b).

Claim 40: The body is biased towards the planar configuration for biasing the plurality of tines towards the central axis (column 8, lines 16-22).

Claim 41, 42, 48, 49: The device disclosed by Spence'692 is formed of a unitary structure and is therefore capable of being formed from a unitary piece of material.

Claim 43: The spring element is capable of being expanded and compressed because it is made out of the same malleable material as the rest of the ring.

Claim 44: The body and spring element are biased towards the compressed state.

Terminal Disclaimer

The terminal disclaimer filed on 19 February 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 7,211,101, 11/675,462, 10/435,104, 11/344,891, and 11/028,133 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on 571-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/
Primary Examiner, Art Unit 3734

/L. B./
Examiner, Art Unit 3734